

Handwritten mark resembling a stylized 'M' or 'J'.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,058	11/29/2000	Benjamin N. Truelove	MICR0519	8668

27792 7590 10/21/2004

MICROSOFT CORPORATION
LAW OFFICES OF RONALD M. ANDERSON
600 108TH AVENUE N.E., SUITE 507
BELLEVUE, WA 98004

EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/726,058	Applicant(s) TRUELOVE ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5/24/04</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, application amendment filed on 6/11/2004.
2. Applicant has amended claims 1-3, 8 and 10-13.
3. Claims 1-23 are pending in the case, claims 1, 13 and 22 are independent claims.
4. Applicant has amended the specification and drawings in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 3/25/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.
5. Acknowledgement is made to applicants submission of replacement drawing Figure 1B. The drawings were received on 6/11/2004. These drawings are acceptable.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

7. Claims 1, 3-9, and 11-23 remain rejected under 35 U.S.C. 102(b) as being anticipated by Russo Borland, "Running Microsoft Word 97", Published by Microsoft Press, Redmond, Washington USA, 1997. "*Russo Borland*" is hereafter referred to as "*Borland*".

8. **In regard to independent claim 1**, the first limitation of the claim is directed toward determining a sample of formats comprising a plurality of formats form a format set. Borland discloses the use of format "Styles" in the figure on page 60. The figure discloses a plurality of formats and related samples.

The second limitation of the claim is directed toward identifying a portion of text to be reformatted. Borland recites: "*To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)*" (page 37, second paragraph).

The third limitation of the claim is directed toward reformatting the text and displaying the result in a preview window. Borland discloses reformatted text in a preview window in the figure on page 61.

9. **In regard to dependent claim 3**, the claim is directed toward selecting a color and font that determines a format set. Borland discloses selecting fonts and colors in the first figure on page 43. The user would select the "Ok" button in the dialog window shown in the first figure on page 43 to determine the selected format set.
10. **In regard to dependent claims 4 and 5**, the claims are directed toward a trained designer defining color schemes (claim 4) and font themes (claim 5). Borland discloses a "*Hiring a Decorator: AutoFormat*" section of his manual, starting on page 35 (second paragraph). Borland also recites: "*Improving the looks of characters means adding decorative touches to the basic appearance of words—selecting the font name, style, size, and colors*" (page 42, second paragraph).
11. **In regard to dependent claim 6**, the claim is directed toward format having a font name, font color and font size. Borland discloses font name, color and size in the first figure on page 43.
12. **In regard to dependent claim 7**, the claim is directed toward a preview window displayed above the document. Borland discloses a preview window dialog box in the figure on page 61. Window's Dialog boxes are displayed above the parent application (in this case the Word document).

13. **In regard to dependent claim 8**, the first limitation of the claim is directed toward receiving a command to add a custom format. Borland discloses adding a new format in the figure on page 60 (see the “*New*” button shown in the figure).

The second limitation of the claim is directed toward adding the custom format to the sample of formats. Borland describes the steps to add a custom format (described as “*Styles*”) on pages 826 to 842. Specifically the dialog box on page 830 (the upper figure on the page) shows the basic custom font-specifying tool, where the user would select the “*Ok*” button to add the custom format to the sample of formats.

The third limitation of the claim is directed toward reformatting the text with the custom format and displaying the reformatted text in the preview window. Borland discloses a custom format (shown as “*Invite*”) used to reformat a section of text, which is displayed in a preview window in the figure on page 834.

14. **In regard to dependent claim 9**, the claim is directed toward a user defined custom format. Borland describes the steps for a user to add a custom format (described as “*Styles*”) on pages 826 to 842.
15. **In regard to dependent claims 11 and 12**, the claims are directed toward identifying the portion of text to be reformatted by text located adjacent to the cursor (claim 11) or text that has been highlighted (claim 12). Borland recites: “*To simply have Word apply a format to your document quickly after you're done adding text,*

set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)" (page 37, second paragraph).

16. **In regard to independent claim 13**, the claim is directed to a system for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
17. **In regard to dependent claim 14**, the claim is directed to a system for performing the method of claim 6, and is rejected with the same rationale.
18. **In regard to dependent claim 15**, the claim is directed to a system for performing the method of claim 4, and is rejected with the same rationale.
19. **In regard to dependent claim 16**, the claim is directed to a system for performing the method of claim 5, and is rejected with the same rationale.
20. **In regard to dependent claim 17**, the claim is directed to a system for performing the method of claim 7, and is rejected with the same rationale.
21. **In regard to dependent claim 18**, the claim is directed to a system for performing the method of claim 8, and is rejected with the same rationale.
22. **In regard to dependent claim 19**, the claim is directed to a system for performing the method of claim 9, and is rejected with the same rationale.
23. **In regard to dependent claim 20**, the claim is directed to a system for performing the method of claim 11, and is rejected with the same rationale.

Art Unit: 2178

24. **In regard to dependent claim 21**, the claim is directed to a system for performing the method of claim 12, and is rejected with the same rationale.
25. **In regard to independent claim 22**, the claim is directed to a user interface for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.
26. **In regard to dependent claim 23**, the claim is directed to a user interface for performing the method of claim 8, and is rejected with the same rationale.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

28. Claims 2 and 10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Borland.

29. **In regard to dependent claims 2 and 10**, the claims are directed toward a computer readable medium with computer executable instructions. Borland discloses reformatting documents as described above. Borland fails to explicitly describe a computer readable medium with instructions, but Borland describes common computer environment capabilities, like saving files (page 132), creating folders (page 133) and exiting applications (page 150).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the teachings of Borland on a computer system, because document format management is typically implemented on a computer system to allow instantaneous document reformatting capabilities.

Response to Arguments

30. Applicant's arguments filed 6/11/2004 have been fully considered but they are not persuasive.
31. **Regarding Independent claim 1**, the applicant recites: *"applicants' recited claim language concerning the step of determining a sample of formats comprising a plurality of formats from a format set is neither taught nor suggested by Borland. According to applicants' specification, a "format set" is defined by a "color set" and a "font set" (see applicants' specification, page 4, lines 19-20). A "color set" comprises a number of colors that if used together, create a professional looking color scheme. For example, a "grape" color set may represent various shades and hues of the color purple (see applicants' specification, page 4, lines 24-28). A "font set" includes a number of fonts that work well within a given theme, such as a font set named "hefty" that includes heavier fonts in various point sizes (see applicants' specification, page 4, lines 20-24). It is from this format set that the method determines a sample of formats comprising a plurality of formats."* (Page 11, second paragraph of the amendment filed 6/11/2004).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"a "format set" is defined by a "color set" and a "font set"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

32. **Also, Regarding Independent claim 1**, the applicant recites: *"The Examiner asserts that Borland anticipates the step of Claim 1 of determining a sample of formats comprising a plurality of formats from a format set and cites the format "styles" in the figure on page 60. Step 1 on page 60 instructs the user to select the paragraph, paragraphs, or text to which the user wants to apply the style. Then the user chooses the Format Style command in step 2 and selects a style. But this section refers only to selecting a single style to apply to the selected text; it does not refer to selecting a set of styles."* And *"Applicants' method seeks to provide a number of "format sets" to a user (see applicants' specification, page 4, lines 12-13)"* and *"Since applicant's method encompasses the format set which comprises a color set and a font set, the format set is more than a single font name, size and color belonging to a style as Borland teaches"* (Page 11, third paragraph to page 12, first paragraph of the amendment filed 6/11/2004).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"selecting a set of styles"* and *"provide a number of "format sets" and "the format set which comprises a color set and a font set"*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the applicant is directed to the rejection of claim 1, as restated above. In further support of this rejection, See page 62 of Borland and consider the

Art Unit: 2178

figure near the top of the page. Borland clearly shows in this figure that a “*style*” has a plurality of formats (shown as “*Font*”, “*Paragraph*”, “*Tabs*”, “*Language*”, “*Frame*”, “*Style*” and “*Highlight*”).

33. **Regarding Independent claims 13 and 22**, the applicant recites: “*distinguishes over Borland for the reasons stated above*” (page 13, second and third paragraphs). The applicant is directed to the rejection of claims 13 and 22, as restated above and to the response to arguments stated above.

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

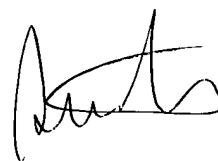
35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
October 14, 2004

A handwritten signature in black ink, appearing to read 'S. Hong', with a stylized, flowing script.

**STEPHEN S. HONG
PRIMARY EXAMINER**